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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,560	11/08/2001	Paul L. Valint JR.	P02785d1	8074
7590 11/04/2003 Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604			EXAMINER SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

10/005,560

**Applicant(s)**

VALINT ET AL.

**Examiner**

Robert Sellers

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26 and 30-43 is/are pending in the application.
- 4a) Of the above claim(s) 26 and 30-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

Newly amended claim 26 and new claims 30-43 are directed to inventions that are independent or distinct from the invention originally claimed.

Original claim 26 defines a copolymer comprising from 1-99 mole percent of an acrylamide, lactam, poly(alkylene oxide) or hydroxyalkyl methacrylate monomer, and from 1-99 mole percent of an azlactone monomer of the depicted formula. Claim 26 amended in the fax filed September 26, 2003 requires a copolymer comprising from 1-99 mole percent of a dimethylacrylamide macromer supported on page 27, line 15 of the specification, from 1-99 mole percent of an acrylamide, vinyl substituted lactam, poly(alkylene oxide) or hydroxyalkyl methacrylate, and from 1-99 mole percent of an azlactone monomer of the depicted formula. The additional presence of the dimethylacrylamide macromer results in a materially different terpolymer from the originally claimed copolymer, thereby indicating a distinct invention.

Independent claim 30 and claims 31-43 dependent therefrom denotes a dimethylacrylamide macromer, a hydrophilic monomer and a reactive monomer which is a distinct invention from both original claim 26 and new claim 26 due to the additional presence of a reactive monomer which yields a functionally diverse terpolymer. The further existence of the hydrophobic monomer of claims 40, 42 and 43 constitutes another distinct invention since the introduction of hydrophobic groups materially alters the physical properties of the copolymer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26 and 30-43 withdrawn from consideration as being directed to a non-elected invention (see 37 CFR 1.142(b) and MPEP § 821.03).

There is no support in the specification for the claimed combination of a dimethylacrylamide macromer together with both an acrylamide, vinyl substituted lactam, poly(alkylene oxide) or hydroxyalkyl methacrylate monomer, and an azlactone monomer in amounts within the claimed parameters of claim 26. There is no substantiation of the blend of dimethylacrylamide macromer, hydrophilic monomer and reactive monomer of claim 30.

New claim 31 is supported by page 28, line 1 to page 29, lines 8-9 (the period is missing from line 3).

New claim 32 is supported by page 29, line 7.

New claim 33 is supported by page 12, lines 8, 11 and 12 with respect to glycidyl (misspelled in the claim) methacrylate, maleic anhydride and itaconic anhydride, and page 31, lines 19-20 regarding 4-vinyl-1-cyclohexen-1,2-epoxide. No support is found for the species of allyl glycidyl ether, 2-alkenyl azlactone and isocyanatomethacrylate (misspelled in the claim).

New claim 34 is supported by page 13, lines 13-21.

New claim 35 is supported by page 18, lines 8-14. There is no antecedent basis for the monomeric unit derived from functionally reactive monomers comprising oxazolinone moieties in claim 30 limited to epoxide-, azlactone-, isocyanate- or acid anhydride-functional monomers. The phrase "selected from" in line 6 is improper Markush language in the absence of the terminology "selected from the group consisting of."

New claim 36 is supported by page 19, lines 5-23.

New claim 37 is supported by page 19, line 26 to page 20, line 3.

New claim 38 is supported by page 13, line 25 to page 15, line 10. The term "such as" in line 5 does not concisely denote the species of water solubilizing groups in the absence of the proper Markush language "selected from the group consisting of . . . and." The phrase "vinyl substituted heterocycles such as vinyl pyridines, vinyl piperidines and vinyl imidazoles and N-vinyl lactams such as N-vinyl-2-pyrrolidinone" in the last two lines does not clearly define the vinyl substituted heterocycles and N-vinyl lactams because the term "such as" renders it unclear whether the species following the term are part of the claimed invention.

New claim 39 is supported by page 14, lines 4-10.

New claim 40 is supported by page 15, line 22 to page 16, line 24.

New claim 41 is supported by page 20, lines 4-7.

New claim 42 is supported by page 12, lines 3-4.

New claim 43 is supported by page 16, line 25 to page 17, line 2.

According to MPEP § 714.03, "[a]pplicant should also specifically point out the support for any amendments made to the disclosure."

Most of the limitations of the new claims are supported by the specification except for the monomer combinations of amended claim 26 and new claim 30, the proportion ranges of the monomer combinations of claim 26 and certain reactive monomers of claim 33. However, these claims are directed to distinct inventions from that originally defined in claim 26 for the reasons espoused hereinabove. There are no active claims present in the instant application directed to the originally claimed subject matter. The newly claimed limitations can only be pursued in a continuation-in-part application due to the unsupported combinations of monomers and amounts recited in amended claim 26 and new independent claim 30.

The 35 U.S.C. 112, second paragraph rejection advanced in the previous Office action would be rescinded if the specification on page 11, line 24 is amended to reflect an "N-vinyl lactam" in accordance with page 15, line 11; and lines 24-25 to describe a "poly(alkylene oxide) methacrylate" along with the amendment of these species in claim 26.

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The amendment filed September 26, 2003 is not fully responsive to the prior Office Action because of newly amended claim 26 and new claims 30-43 directed to distinct inventions as explained hereinabove (see 37 CFR 1.111). Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

(703) 308-2399 (Fax no. (703) 872-9306)  
Monday to Friday from 9:30 to 6:00 EST



Robert Sellers  
Primary Examiner  
Art Unit 1712

rs  
10/27/03